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PATENT
Customer No. 22,852
Attorney Docket No. **02481.1763**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Uwe HEINELT *et al.*	Group Art Unit: 1624
Serial No.: 10/020,241	Examiner: Deepak R. Rao
Filed: December 18, 2001	
For: SUBSTITUTED HETEROCYCLO-NORBORNYLAMINO DERIVATIVES, PROCESSES FOR THEIR PREPARATION, THEIR USE AS MEDICAMENTS OR DIAGNOSTICS, AND MEDICAMENTS COMPRISING THEM	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action dated April 23, 2003 (Office Action), Applicants respectfully request reconsideration of this application in view of the following remarks. Claims 1-34 are pending in this application. In the Office Action, the Examiner required restriction of the pending claims under 35 U.S.C. § 121 between the following groups:

Group I, Claims 1-5 and 33-34;

Group II, Claim 6;

Group III, Claims 7-8;

Group IV, Claims 9-11;

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Group V, Claim 12;

Group VI, Claims 13-15;

Group VII, Claim 16;

Group VIII, Claims 17-20;

Group IX, Claims 21-24;

Group X, Claims 25-27;

Group XI, Claims 28-29;

Group XII, Claim 30;

Group XIII, Claim 31; and

Group XIV, Claim 32.

Restriction Requirement

Applicants elect, with traverse, to prosecute the claims of Group I, claims 1-5 and 33-34.

Applicants traverse on the ground that the Examiner has failed to show that the joint examination of claims from Groups I to XIV would be a serious burden, other than to mention that the inventions are distinct. The Examiner's attention is respectfully directed to M.P.E.P. § 803, which sets forth criteria and guidelines for a proper requirement for restriction. The M.P.E.P. instructs the Office as follows:

> If the search and examination of an entire application can be made without **serious** burden, the Office must examine it on the merits, **even though it includes claims to distinct or independent inventions**. M.P.E.P. § 803 (emphasis added).

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Because the Examiner has not shown that it would be unduly burdensome to perform a search for all the pending claims, Applicants respectfully request that Groups I to XIV be examined together.

Furthermore, a joint search of Groups II to VII would not be burdensome because all of the claims in these groups are drawn to processes for the preparation of compounds of Group I. Therefore, a proper search for any group of claims from among Groups II to VII would overlap with the searches for the other groups. For at least this reason, Applicants request that the Examiner examine the claims of Groups II to VII together.

Claims subject to rejoinder

Moreover, Applicants respectfully remind the Examiner that in view of the court findings in *In Re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996), claims directed to processes of making or using a compound are subject to rejoinder with claims drawn to that compound once the compound is found patentable. *See also* M.P.E.P. §2116.01.

Pursuant to this rejoinder procedure, Applicants respectfully request that claims 1-34 (claims drawn to compounds of Formula I or Ia, and claims drawn to methods of using and making those compounds) be examined together in this application.

Election Requirement

In the Office Action, the Examiner also required election under 35 U.S.C. § 121 of a single species that falls within the elected group.

Applicants elect, with traverse, (exo/endo)-(octahydro-4,7-methanoinden-5-yl)pyridin-3-ylmethylamine (Example 1). Applicants traverse on the ground that the

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claims do not define an unreasonable number of compounds. *See* 37 C.F.R. § 1.141. Moreover, it would be unreasonable to require Applicants to file many separate applications, one for each possible compound.

Pursuant to 37 C.F.R. § 1.146, should the elected species be found allowable, Applicants respectfully request that the Examiner continue to examine the full scope of the claimed subject matter to the extent necessary to determine the patentability thereof, i.e., extending the search to the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121. Furthermore, the proper search for the elected species would overlap with the search of the genus of compounds described by formulas I and Ia. Therefore, Applicants respectfully request that the scope of the examination be broadened to include compounds of formulas I and Ia. *See* 37 C.F.R. § 1.141(a).

CONCLUSION

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: _____
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Dated: May 22, 2003

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